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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/427,938	10/27/1999	JOHN S. HENDRICKS	026880.00004	3963

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ARENT FOX LLP  
1050 CONNECTICUT AVENUE, N.W.  
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WASHINGTON, DC 20036

EXAMINER
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WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2445

NOTIFICATION DATE	DELIVERY MODE
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12/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/427,938	HENDRICKS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Patrice Winder	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9-18 and 20-28 is/are rejected.
- 7) ☒ Claim(s) 3-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-4-2009; 11-30-2009</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 28, 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 9-18, 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al., USPN 5,926,624 (hereafter referred to as Katz) in view of Berger, USPN 5,978,841 (hereafter referred to as Berger)

4. Regarding claim 1, Katz taught a virtual on-demand electronic book system (abstract) , comprising:

a main memory located at a local library that stores electronic books for delivery to electronic book viewers of subscribers in the system via at least one of an internet

Art Unit: 2445

network, a cable telephone network, and a broadcasting network (column 4, lines 41-67), wherein the electronic books are received from at least one remote provider (column 6, lines 5-10, 23-28), and each of the electronic book viewers of the subscribers includes a local memory (column 5, lines 21-26);

a queuing processor coupled to the main memory that receives electronic book orders from the subscribers (column 9, lines 14-20) and determines a queue location for an ordered electronic book, wherein each electronic book is divided into a plurality of sections (column 6, lines 5-10, 42-62);

first queues that temporarily store first sections of electronic books (column 7, lines 2-8); and second queues that temporarily store second sections of electronic books (column 7, lines 2-8),

wherein the electronic books include order-on-demand electronic books (digital content information) and predetermined popular electronic books selected based on one of a request rate and a promotion level (targeted digital content information, column 12, lines 49-52), the order-on-demand electronic books are received from the at least one remote provider upon requests from the subscribers (column 5, lines 60-65) and the predetermined popular electronic books are pre-loaded into at least one of the main memory and the local memory of the electronic book viewers of the subscribers (column 13, lines 30-43),

wherein the first sections of electronic books are delivered to the subscribers without charge (previews, column 8, lines 8-12) and the second sections of electronic

Art Unit: 2445

books are delivered when an order for the electronic books is made by a subscriber (purchasing electronic book, column 8, lines 30-40),

wherein the first sections of the electronic books stored in the local memory of the electronic book viewer are ignored if the second sections of the electronic books are not requested by the subscriber after a predetermined period of time (column 11, lines 8-14; column 15, lines 7-12), and

wherein the first queues further include a true on-demand first sections queue, a popular content first sections queue (requested digital content information and group digital content information); and

wherein the second queues further include a true on-demand second sections queue and a popular content second sections queue (other segments of requested digital content information and other segments of group digital content information).

Katz does not specifically teach deleting and the true on-demand first section queue has a highest priority. However, Berger taught deleting partial portions of previewed files (column 9, lines 15-17, 66-67; column 10, lines 1-7) and taught the true on-demand first section queue has the highest priority (column 8, lines 2-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Berger's file management in Katz's content delivery system would have improved system robustness. The motivation would have been to implement a file management system that adjusts the files retained based on memory capacity..

5. Regarding dependent claim 9, Katz taught system of claim 1, further comprising: a service time guarantee (lightly loaded library server); and a network coupling the

Art Unit: 2445

processor to an associated data processing system (other library server), wherein the processor determines a pending service time, wherein if the pending service time exceeds the guarantee (overloaded), the processor establishes a connection with the associated data processing system, and wherein the associated data processing system processes electronic book orders (column 16, lines 5-11).

6. Regarding dependent claim 10, Katz taught system of claim 1, further comprising: an electronic book viewer (mobile playback device 212) comprising:

a receiver that receives electronic books, a transmitter that transmits electronic book orders, and a memory coupled to the receiver that stores the electronic books; and a processor coupled to the receiver and the memory that controls processing on the electronic book viewer, wherein the receiver receives broadcasts of first sections of electronic books and stores the first sections in the memory (column 16, lines 63-67; column 17, lines 1-40).

7. Regarding dependent claim 11, Katz taught system of claim 10, Katz taught wherein when a first section stored in the memory is accessed, the processor generates an order for a corresponding second section, and the transmitter transmits the order (column 15, lines 35-44).

8. Regarding dependent claim 12, Katz taught system of claim 10, wherein a first section of the electronic book includes a link, wherein when the link is accessed, the processor generates an order for a corresponding second section of the electronic book (column 15, lines 35-44).

Art Unit: 2445

9. Regarding dependent claim 13, Katz taught system of claim 1, wherein the electronic books comprise an electronic version of one or more of a printed book, a magazine, a catalog, a periodical and a newspaper (column 5, lines 46-60).
10. Regarding dependent claim 14, Berger taught system of claim 1, wherein specified electronic books are broadcast on a cyclical basis (column 13, lines 9-22).
11. Regarding dependent claim 15, Berger taught system of claim 1, wherein first sections of specified electronic books are broadcast on a cyclical basis (partial preload, column 13, lines 9-22).
12. Regarding dependent claim 16, Katz taught system of claim 15, wherein the first sections to be broadcast are determined by reference to one of electronic books read data, demographic data, and subscriber preferences (target to group, column 13, lines 34-58).
13. Regarding dependent claim 17, Katz taught system of claim 1, further comprising a virtual on-demand menu, the virtual on-demand menu broadcast with a broadcast of one of an electronic book and a first section of an electronic book, wherein the virtual on-demand menu lists electronic books available on the virtual on-demand electronic book system (column 6, lines 42-64).
14. The language of claims 18, 20-24 recites a computer system functions similarly to the system of previously rejected claims 1, 3-17. Therefore, claims 18, 20-24, 26 are rejected on the same rationale as previously rejected claims 1, 3-17, above.
15. Regarding dependent claim 25, Katz taught computer system of claim 18, wherein the processor section determines when multiple electronic book orders are for

Art Unit: 2445

a same electronic book, the processor section aggregating the multiple electronic book orders (column 8, lines 45-48), and wherein the computer system simultaneously broadcasts multiple copies of the same electronic book (targeting client according to group ID, column 11, lines 39-45).

16. Regarding dependent claim 27, Katz taught computer system of claim 25, wherein a second section queue includes second sections of selected electronic books (column 7, lines 2-8).

17. Regarding dependent claim 28, Katz taught system of claim 27, wherein the second sections are delivered when ordered by subscribers of the computer system (column 9, lines 1-6).

### ***Allowable Subject Matter***

18. Claims 3-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or suggest a queue server that empties the first and second queues based on a priority model.

### ***Response to Arguments***

20. Applicant's arguments with respect to claims 1, 3-18, 20-28 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrice Winder/  
Primary Examiner, Art Unit 2445

December 21, 2009